

## **Claim Rejection – 35 USC 103**

Claims 1-23, 27 and 28 stand rejected under 35 USC 103(a) in view of Herzberg (US 3,105,970) in view of Helen Joseph-Armstrong's "Pattern Making for Fashion Design" (pp. 226-227, 217). This rejection is respectfully traversed.

References are only properly combinable if there is a teaching or suggestion in the prior art that such a combination be made. The suggestion must come from the prior art itself, "not in the applicant's disclosure". *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). See also *Smiths Industries Medical Systems v. Vital Signs, Inc.*, 51 USPQ2d 1415, 1419 (Fed. Cir. 1999):

"Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved."

Here there is clearly no such teaching. The "problem" solved by Herzberg is making a scarf that drapes attractively, not the creation of a scarf with enhanced insulating properties created by the formation of insulating air pockets within the scarf.

Several of the features characterized by the Examiner as included in Herzberg are not supported by the reference itself:

- (1) there is no teaching or suggestion in Herzberg that any air chamber is formed between adjacent layers of fabric when the scarf of Herzberg is donned.
- (2) as the Examiner notes, Herzberg does not disclose that the dimensions A

and B are different with A and B being the dimensions of the front and rear panels from the top seam to the apex.

Indeed, a fair reading of Herzberg shows that the front and rear panels 14, 16 are identical in size. The Examiner has stated that the pleats in Herzberg “form at least one air chamber proximate to the top seam (Fig. 8).” Applicant respectfully contends that no air chamber is shown in Fig. 8 and reading the reference as a whole we find no suggestion that air pockets are created when the scarf is put on. In fact, Herzberg teaches the creation of folds proximate the neck and a fair reading of the reference shows that these folds include the front and rear panels (and any interpanel that is present) because the front, rear and inter panels are essentially congruent, there is no structure to create natural air pockets when the scarf is fastened about a user’s neck. Herzberg stresses that the folds create an attractive appearance (“This construction causes the scarf to drape automatically and attractively upon putting it on.” Col. 1 l. 70 - col. 2, l. 1)

Thus, there is no teaching or suggestion that the construction of Herzberg is intended to create an insulating air pocket when donned.

Applicant respectfully contends that the Joseph-Armstrong reference teaches the formation of permanent pleats on a single layer of fabric but lacks any teaching that the pleats form air pockets between two layers of fabric when the garment is worn. In particular, there is no teaching or suggestion in Joseph-Armstrong to combine a blouse, where the back and front panels contact the body, with a scarf where the back and front panels contact each other and the back panel alone contacts the body.

The pattern of Joseph-Armstrong teaches a blouse with front and rear panels which are intended to fit around the body. The Joseph-Armstrong reference teaches the creation of a pattern which is cut to be spread apart. When the resulting cloth panel is cut from the pattern, it is then folded and stitched together to form the pleats. It is then sewn to a back panel creating a garment that is open at the neck and waist and does not in the least suggest that the garment

construction is intended to create an enclosed air pocket between two layers of fabric.

As the Examiner has noted, there is no teaching in Herzberg to disclose that dimensions A and B are different and thus, there is no teaching that would support the combination of these two references. It is simply not obvious to take a reference that teaches panels of congruent sizes and read into that reference a suggestion that one of the panels be made larger than the other to create air pockets. Herzberg teaches folds, not air pockets. Without prior consideration of Applicant's disclosure there would be no reason to consider combining these two references.

Claims 24-26 and 28-30 stand rejected under 35 USC 103(a) as being unpatentable over Herzberg and Joseph-Armstrong as applied above and further in view of Haliczer (U.S. 2,752,916).

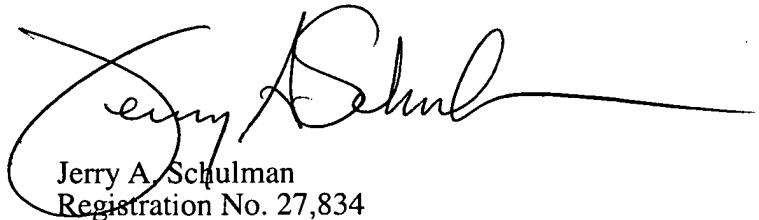
For the reasons expressed above, claim 26 is allowable over the art of record. The remaining claims depend from claims that is allowable and therefore, should be allowed as well.

Applicant notes the Examiner's reference to Thompson (U.S. 5,414,689) and Walker (U.S. 5,720,052) as pertinent to applicant's disclosure.

### Conclusion

Applicant respectfully contends that the application, with claim 1 as amended, and with claims 2-30 is in condition for allowance. Reconsideration and passage to allowance is respectfully requested. Should the Examiner have any remaining questions, please telephone the undersigned directly.

Respectfully submitted,



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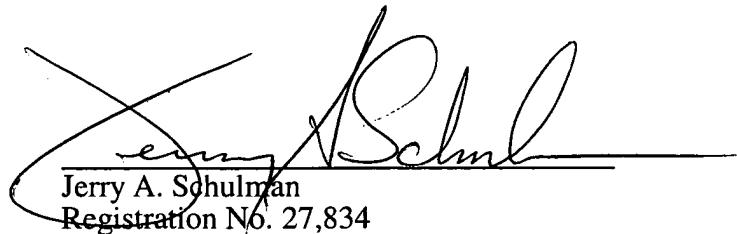
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**CERTIFICATE OF MAILING**

Date of Deposit: February 8, 2006

I hereby certify that the foregoing correspondence, consisting of RESPONSE TO FIRST OFFICE ACTION, FORMAL DRAWINGS and INFORMATION DISCLOSURE STATEMENT was deposited with the U.S. Postal Service as first class mail, postage prepaid, on the date indicated above and is addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.



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